

REMARKS

I. Introduction

Claims 1-51 are pending in the present application. Claims 26-51 are new. Claims 1-25 were rejected. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration of the pending claims is respectfully requested.

II. Rejection of Claims 13, 14, 16, 17, 20, 21, 24 and 25 under 35 U.S.C. § 112

Claims 13, 14, 16, 17, 20, 21, 24, and 25 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement by using the term “trade dress” in the claims but not addressing it in the specification. Applicants respectfully submit that the rejection should be withdrawn for at least the following reason.

The term “trade dress” is used in an advertising context and should be known and easily determined by those skilled in the art. The Manual of Patent Examining Procedure (MPEP) § 2164.01 specifies that “the claimed invention be enabled so that one skilled in the art can make or use the invention **without undue experimentation**” (emphasis added) and that a “patent need not teach, and preferably omits, what is well known in the art.” Examiner rejects the aforementioned claims on the grounds that the term “trade dress” is not mentioned in the specification. The term “trade dress” is defined in many encyclopedia and dictionaries either in print or online. For example, “trade dress” is defined as “in trademark law, trade dress refers to the distinctive design of a product or of its packaging, considered as a trademark.” TheFreeDictionary.com, www.thefreedictionary.com (May 3, 2004). Applicants respectfully contend that someone skilled in the art should know and can easily determine the definition of “trade dress”. The specification discusses examples of advertising content information and the term “trade dress” is used in the rejected claims in the context “content information includes at least one of a video content intent, an audio

content item, a logo, and a trade dress item.” Original claims 13, 16, 20, and 24 upon which original claims 14, 17, 21, and 25 respectively depend. The term “trade dress” should be familiar in the advertising art—the context in which it is used. For this reason, Applicants respectfully request the withdrawal of this rejection.

III. Rejection of Claims 1-3 and 12-22 under 35 U.S.C. § 102(b)

Claims 1-3 and 12-22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Planet 9 studios, www.planet9.com (“Planet 9 studios”). Applicants respectfully submit that the anticipation rejection should be withdrawn for at least the following reason.

In support of the rejection, Examiner relies on the Planet 9 studios reference without providing a publication date. If a publication does not include a publication date, it cannot be relied upon as prior art. The phrase printed publication as recited in the statute requires that before the critical date the reference must have been sufficiently accessible to the public interested in the art, dissemination and public accessibility are the keys to the legal determination of whether a prior art reference was published. In re Cronyn, 890 F.2d1158, 1160 (Fed. Cir. 1989). In the present case, the Examiner has failed to show that Planet 9 studios was disseminated or accessible, as further discussed below.

The MPEP indicates that an electronic publication, including an on-line database or Internet publication, is considered to be a printed publication provided the publication was accessible to persons concerned with the art to which the document relates. Regarding date of availability, this section of the MPEP indicates that prior art disclosures on the Internet or on an on-line database are considered to be publicly available as of the date the item was publicly posted. If the publication does not include a publication date (or a retrieval date), it can not be relied upon as prior art under 35 U.S.C. § 102 (a) or (b). MPEP § 2128.

Examiner solely relies on printouts from the Planet 9 studios Web site, www.planet9.com, that were likely made after the filing date of this application, in order to make the rejection under 35 U.S.C. § 102(b). No date of publication of the material is provided and, according to MPEP § 2128, it can't be relied upon as prior art. The copyright date on some of the printed pages does not equate to a publication date of the material. It is common knowledge that the content of Web sites is dynamic and constantly changing and, in fact, several pages of the Web site cited by the Examiner are no longer accessible. Furthermore, the copies of the pages provided by the Examiner are black and the features cited by the Examiner are often not discernible and can not be appropriately reviewed. For this reason, Applicants respectfully request withdrawal of this rejection.

IV. Rejection of Claims 4 and 5 under 35 U.S.C. § 103(a)

Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Planet 9 studios, www.planet9.com, in view of U.S. Patent No. 6,219,045 to Leahy et al. ("Leahy"). Applicants respectfully submit that the obviousness rejection should be withdrawn for at least the following reasons.

In support of this rejection, Examiner primarily relies on the Planet 9 studios reference without providing a publication date as stated above. The standard for a 35 U.S.C. § 103(a) rejection requires an analysis of the prior art similar to 35 U.S.C. § 102. If a publication does not include a publication date, it cannot be relied upon as prior art.

"Before answering Graham's 'content' inquiry, it must be known whether a patent or publication is in the prior art under 35 U.S.C. § 102." Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568, 1 U.S.P.Q.2d 1593, 1597 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987) (referring to Graham v. John Deere factual inquiries to determine obviousness under U.S.C. § 103).

As discussed above in Section III above, “if the publication does not include a publication date (or retrieval date), it cannot be relied upon as prior art under 35 U.S.C. 102(a) or (b)”. MPEP § 2128. Applicants respectfully submit that the Planet 9 studios reference is not valid prior art under MPEP § 2128 and request the withdrawal of the rejection for the aforementioned reasons.

V. Rejection of Claims 6 and 9 under 35 U.S.C. § 103(a)

Claims 6 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Planet 9 studios, www.planet9.com, in view of U.S. Patent No. 6,498,982 to Bellesfield et al. (“Bellesfield”). Applicants respectfully submit that the obviousness rejection should be withdrawn for at least the following reasons.

Applicants contend that the same defect in the Planet 9 studios reference apply to this rejection. Contrary to Examiner’s contention, even if the Planet 9 studios reference was valid prior art, Bellesfield fails to remedy the deficiencies in Planet 9 studios. In order to establish obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

In support of the rejection, Examiner contends that Planet 9 studios and Bellesfield teach all the claim limitations. Applicants respectfully submit that Planet 9 studios, as presented by the Examiner, and Bellesfield teach neither the step of “determining an orientation relative to the entity, wherein the orientation corresponds to a movement along the route” found in claim 6 or determining route marking information including at least one of 2-D and a 3-D effect in a photorealistic, 3-D environment found in claim 9. A “town” or “tour” button on a Web page (Office Action dated Feb. 6, 2004, Fig. 1, element 2 cited on page 7) may show movement but does not indicate an orientation relative to the entity—the orientation corresponding to user perspective during movement in three-dimensional space. Orientation, as purely angular positioning, or

movement, as purely motion within a three-dimensional environment, is not the same as “the orientation corresponds to a movement along the route.” Claim 6. In the present application, an orientation can be one in a series of orientations that occur during movement with the orientation linked to the movement. The prior art relied upon, even if valid in light of the arguments presented above, does not teach or suggest all the limitations of these claims.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

The combination of Planet 9 studios and Bellesfield is not suggested by the provided prior art. Examiner’s reference to Bellesfield merely states the desirability of automating route planning but includes no mention of three-dimensional or photorealistic environments, orientation during movement within these environments, or route marking within these environments. Office Action, pg. 7, and Bellesfield, col 1, ln 35. For these reasons, Applicants respectfully request the withdrawal of this rejection.

VI. Rejection of Claims 7, 8, 10, and 11 under 35 U.S.C. § 103(a)

Claims 7, 8, 10, and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Planet 9 studios, www.planet9.com, and U.S. Patent No. 6,498,982 to Bellesfield et al. (“Bellesfield”) in view of Mapquest.com (“Mapquest”). Applicants respectfully submit that the obviousness rejection should be withdrawn for at least the following reasons.

In support of the rejection, Examiner states that the Planet 9 studios and Bellesfield prior art references teach all the limitations of claims 6 and 9. In the previous

section, it was shown that limitations in both claims 6 and 9 are not addressed by either of these prior art references. Claims 7 and 8 depend on claim 6 and claims 10 and 11 depend on claim 9. The Mapquest.com reference does not cure these deficiencies. Additionally, the previously noted concern regarding the Planet 9 studios reference as valid prior art exists. Also, Examiner makes no specific mention of a published feature of Mapquest. For these reasons, Applicants respectfully request the withdrawal of this rejection.

VII. Rejection of Claims 23, 24, and 25 under 35 U.S.C. § 103(a)

Claims 23, 24, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Planet 9 studios, www.planet9.com, in view of U.S. Patent No. 6,271,843 to Lektion et al. ("Lektion"). Applicants respectfully submit that the obviousness rejection should be withdrawn for at least the following reasons.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

The combination of Planet 9 studios and Lektion is not suggested by the provided prior art. Lektion specifically states that "the transportation vehicle is preferably modeled after real-life vehicles such as an automobile, taxi, bus, subway, trolley, or other suitable type of transportation vehicle that would provide the user with a virtual experience that is closely analogous to reality." Lektion, col 7, ln 11-16. However, Lektion never discusses a photorealistic representation of either the vehicle or the virtual world, instead often referring to transportation between or within virtual worlds (intra- or inter-world transportation). This reference to a model simulating a vehicle is not the same as a photorealistic representation and this reference in Lektion is

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only used for the vehicle and never the virtual world. No suggestion is made in either
Lecture or in the Planet 9 studios references, as provided by the Examiner, as to the
utility or combination of the two. In addition, the arguments made above regarding the
publication date of the Planet 9 studios prior art reference also applies to this rejection.
For these reasons, Applicants respectfully request the withdrawal of this rejection.

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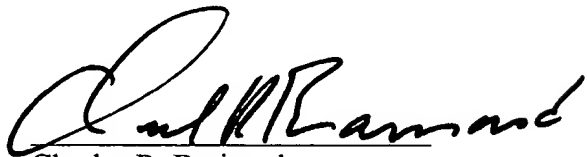
CONCLUSION

Applicants respectfully submit that all pending claims of the present application are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

The Office is authorized to charge any fees associated with this Amendment to Kenyon & Kenyon Deposit Account No. 11-0600.

Respectfully submitted,

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